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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,440	07/18/2006	Futoshi Nakabe	2006_0836A	5602
52349 7590 08/17/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
KELLY, RAFFERTY D				
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2876				
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08/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/586,440

Applicant(s)

NAKABE ET AL.

Examiner

RAFFERTY KELLY

Art Unit

2876

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination filed on 6/2/09 has been acknowledged and as a result, amendment filed on 4/27/09 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-9, 13-17, and 19-21 rejected under 35 U.S.C. 103(a) as being unpatentable over "Identification cards - Contactless integrated circuit(s) cards - Proximity cards" (XP-001146902, hereinafter 14443-3) in view of Berger et al. (US 6168083) and Brandys (US 2002/0186838 A1).

Regarding claims 1 and 13-16, 14443-3 teaches a contactless card that communicates with a reader/writer after being supplied with electric power, the contactless card having an identifier that identifies the contactless card, the contactless card comprising: a power detection unit operable to detect electric power enough to communicate with the reader/writer (7.4.3 and 7.4.5); an identifier storage unit operable to hold the identifier that identifies the contactless card (this feature is inherent in 14443-3 because the identifier is created and manipulated by the card, thus it must be stored somewhere); a receiving unit operable to receive, from the reader/writer, a command requesting that the identifier that identifies the contactless card be sent to the reader/writer (6.3.1 or 7.4.5); a sending unit operable to send, to the reader/writer, the

identifier that identifies the contactless card (7.4.1 – “Send ATQB”); a mode judgment unit operable to judge an operation mode in which the card operates (card judges whether it is operating in mode 'A' or mode 'B' by what kind of REQ it receives); a random identifier generation unit operable to generate an identifier in a random manner (ATQA/UID is random – 6.4.4); and a specific identifier generation unit operable to generate a specific identifier (ATQB/PUPI - 7.9.2), wherein the judged operation mode in which the contactless card operates determines which one of (i) the identifier generated by the random identifier generation unit and (ii) the identifier generated by the specific identifier generation unit, is to be used as the identifier that identifies the contactless card (based on whether REQA (6.4.1) or REQB (7.4.1) is received).

14443-3 lacks making a judgment based on voltage.

Berger et al. teaches wherein a contactless card operates by judging whether or not a voltage at a predetermined point in the contactless card is a predetermined voltage (Col. 2 Lines 35-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use voltage at a point to determine an operating mode because it can indicate whether a card is being used in contact or non-contact modes, which are two very common modes of operation of an IC card.

Berger et al. also lacks determining an operation mode solely and independently of information received by the receiving unit.

Brandys teaches determining a mode solely and independently of information received by the receiving unit (enrollment mode - Fig. 2, signing mode - Fig. 3).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to determine an operation mode independently of information received by the receiving unit because it allows the user to determine a mode of operation of the card regardless of how the card is being used. This allows for a more versatile smart card.

Regarding claim 2, 14443-3 in view of Berger and Brandys teaches the contactless card according to claim 1, as shown above. 1444—3 further teaches wherein every time the power detection unit detects the enough electric power, one of the random identifier generation unit and the specific identifier generation unit generates a new identifier (7.9, 7.9.2 - REQB powers the card up, and ATQB is sent upon receipt of REQB, ATQB contains identifier) (UID - 6.4.4 or PUPI - 7.9.2)

Regarding claim 5, 14443-3 in view of Berger and Brandys teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches wherein the random identifier generation unit is operable to generate the identifier in a random manner by using a random number (UID 6.4.4 uses random numbers).

Regarding claim 6, 14443-3 in view of Berger and Brandys teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches a communication end detection unit operable to detect an end of a communication between the reader/writer and the receiving unit and the sending unit (7.4.6 - reception of REQB), wherein, in a case where the communication end detection unit detects the end of the communication, one of the random identifier generation unit and the specific identifier generation unit generates a new identifier, and the new identifier is stored in

the identifier storage unit as the identifier that identifies the contactless card (7.4.1 – “Wait for Matched ATTRIB or HLTB”, from this step a REQB ends current communication and starts over, requiring a new ATQB/identifier).

Regarding claim 7, 14443-3 in view of Berger and Brandys teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches wherein the communication between the reader/writer and the contactless card is in compliance with the ISO/ICE1443 (title page of 14443-3), and the identifier that identifies the contactless card sent by the sending unit is set as a Pseudo-Unique Proximity Integrated Circuit Card Identifier included in a response to the command that is sent from the reader/writer to the receiving unit (7.9.2).

Regarding claim 9, 14443-3 in view of Berger and Brandys teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches wherein the operation mode in which the contactless card operates includes: an inspection mode indicating that the contactless card is in an inspection process; and a use mode indicating that the contactless card is in use. These two specific modes are merely intended use and do not provide any further structure to the claims, as such, any two modes used in a card are sufficient to meet these particular limitations. In the present 14443-3 reference, the two modes, A and B, require the same structure as the modes presented in the claims, and thus read on the claimed modes. 14443-3 further teaches the identifier determination unit is operable to determine, in mode B, that the identifier generated by the specific identifier generation unit is the identifier that identifies the contactless card (REQB/ATQB is the first mode), and to determine, in

mode A, that the identifier generated by the random identifier generation unit is the identifier that identifies the contactless card (REQA/ATQA is the second mode).

Regarding claim 17, 14443-3 in view of Berger and Brandys teaches the contactless card according to claim 1, as shown above.

14443-3 lacks the specifics of detecting the voltage.

Berger teaches further comprising: a voltage measurement unit operable to measure the voltage at the predetermined point in the contactless card (Col. 2 Lines 35-45); and wiring for fixing the voltage at the predetermined point to a first voltage or a second voltage by connection or disconnection with the predetermined point (Col. 4 Line 65 – Col. 5 Line 3), wherein the mode judgment unit is operable to judge the operation mode depending on whether the voltage measured by the voltage measurement unit is the first voltage or the second voltage (Col. 5 Lines 1-8).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use voltage at a point to determine an operating mode because it can indicate whether a card is being used in contact or non-contact modes, which are two very common modes of operation of an IC card.

Regarding claims 19-21, 14443-3 in view of Berger and Brandys teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches wherein the identifier generated by the specific identifier generation unit is a fixed identifier and the identifier generated by the random identifier generation unit is a non-fixed identifier. "Fixed" and "non-fixed" identifiers are implied by the fact that the identifiers are specifically generated and randomly generated. The terms "fixed" and

"non-fixed" must be given their broadest reasonable interpretation and in the present case, something that is randomly generated could be considered "non-fixed" and something that is specifically or procedurally generated could be considered "fixed".

2. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over 14443-3 as modified by Berger and Brandys and in further view of Nakabe et al. (US 2003/0094491). The teachings of 14443-3 as modified by Berger and Brandys have been discussed above.

Regarding claim 10, 14443-3 as modified by Berger and Brandys teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches wherein the specific generation unit is operable to generate the identifier based on information stored in a memory (because 14443-3 teaches generating the identifier, it must be based on some information already present in the memory of the device).

14443-3 lacks the specifics of the memory.

Nakabe et al. teaches storing card identification information in a read-only memory wherein the information stored in the read only memory is not rewritable [0062].

It would have been obvious to one of ordinary skill in the art at the time of invention to use ROM to store the identifier information because it allows for very reliable and secure storage when compared to other memory types.

3. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over 14443-3 as modified by Berger and Brandys and in further view of Guenther (US 6111951). The teachings of 14443-3 as modified by Berger and Brandys have been discussed above.

Regarding claims 11 and 12, 14443-3 as modified by Berger and Brandys teaches a contactless card according to claim 1, as shown above.

14443-3 lacks the specifics of the memory.

Guenther teaches wherein the specific identifier generation unit is operable to generate the identifier based on information stored in a non-volatile memory wherein the information stored in the non-volatile memory is rewritable, wherein the non-volatile memory is one of an electrically erasable programmable read only memory (Col. 6 Lines 7-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use EEPROM to store the identifier because EEPROM allows for data that can be altered and written (allowing for a more dynamic identifier), but also will be saved when not being powered.

Response to Arguments

Applicant's arguments filed 4/27/09 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1 and 13-16 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the argument with respect to claim 10, that Nakabe does not teach generating an identifier based on information stored in a read only memory, this argument is not found to be persuasive. Nakabe is only relied upon to teach storing card identification information in a read only memory. "Card identification information" must be given its broadest reasonable interpretation. In the present case, card identification

information can be any data that is used in the card identification process. Therefore, the information discussed in paragraph 0062 of Nakabe is identification information and it is stored in ROM 204.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAFFERTY KELLY whose telephone number is (571)270-5031. The examiner can normally be reached on Mon. - Fri. 800-1730 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michael G Lee/
Supervisory Patent Examiner, Art Unit 2876